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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,837	08/29/2001	Shawn R. Gettemy	PALM-3651	8549

7590 09/25/2007  
WAGNER, MURABITO & HAO LLP  
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EXAMINER
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PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
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2629

MAIL DATE	DELIVERY MODE
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09/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/942,837	<b>Applicant(s)</b> GETTEMY ET AL.	
	<b>Examiner</b> Jeff Piziali	<b>Art Unit</b> 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed (on 19 July 2007) in this application after final rejection (mailed 19 April 2007). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 July 2007 has been entered.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 3, 6, 8, 9, 35, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by *Suzuki (US 6,529,188 B1)*.

Regarding claim 1, Suzuki discloses a display assembly for an electronic device comprising: a display [Fig. 10; 1]; a digitizer [Fig. 10; 4] disposed above said display and for providing an input to said electronic device in response to a deformation of said digitizer (see Column 13, Line 50 - Column 14, Line 29); and a cover [Fig. 1A; 4A] disposed above said digitizer [Fig. 1A; 11 and 12] and for enabling said deformation of said digitizer in response to a contact with said cover, wherein said cover overlaps (i.e., *to lie or extend over and cover a part of; to partially extend over; coincide partially or wholly*) a side of said display (see Fig. 12; Column 7, Line 42 - Column 8, Line 67).

Regarding claim 3, Suzuki discloses said cover further comprises a flexible thermoplastic film [Fig. 1A; 4A] and a supporting structure [Fig. 1A; 4B] coupled to said flexible thermoplastic film (see Column 10, Lines 46-52).

Regarding claim 6, Suzuki discloses said cover further comprises a decorative border [Fig. 11A; 15 and 20] (see Column 14, Lines 30-54 -- *wherein the border inherently serves an esthetic purpose*).

Regarding claim 8, Suzuki discloses said digitizer comprises electrical traces and circuits along a periphery that are hidden from view by said decorative border (see Figs. 5 and 11A).

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Regarding claim 9, Suzuki discloses said cover comprises indentations to indicate button functions (see Fig. 12; Column 14, Line 55 - Column 15, Line 21).

Regarding claim 35, Suzuki discloses said first cover comprises at least one transparent portion [Fig. 1A; 4A] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 36, Suzuki discloses said digitizer comprises a resistive digitizer [Fig. 10; 4] (see Column 13, Line 50 - Column 14, Line 29).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5, 10, 11, 13, 15, 17-19, 21, 22, 24, 25, 29-34, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Suzuki (US 6,529,188 B1)* in view of *Conroy et al (US 5,686,705 A)*.

Regarding claim 2, Suzuki discloses said digitizer comprises a conductive film made of indium tin oxide [Fig. 5; 11] disposed above a digitizing element [Fig. 5; 22] (see Column 10, Lines 46-52).

However, Conroy does disclose substituting conductive digitizer wires with a conductive polymer composite, such as conductive plastic (see Column 3, Lines 9-30, Column 4, Lines 21-32, Column 5, Line 55 - Column 6, Line 10, and Column 8, Lines 37-40).

Suzuki and Conroy are analogous art, because they are from the shared field of manufacturing electronic touch panel devices. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use Conroy's conductive polymer in place of Suzuki's conductive film, so as to provide a rugged and reliable electronic device.

Regarding claim 5, Suzuki discloses said digitizer further comprises a plurality of electrodes and traces [Fig. 1A; 11 and 12] operable to register a point of contact when said conductive polymer makes contact with said digitizing element (see Column 7, Line 42 - Column 8, Line 67).

Regarding claim 10, this claim is rejected by the reasoning applied in rejecting claim 1; furthermore, although Suzuki does not expressly disclose a processor coupled to memory; Conroy does disclose a portable electronic device [Fig. 4; 116] comprising: a processor [Fig. 4; 142]; and a memory [Fig. 4; 145, 147] coupled to said processor (see Column 11, Lines 4-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use Conroy's electronic circuitry with Suzuki's display assembly, so as to provide a rugged and reliable electronic device, as well as to accurately determine a location selected by a user.

Regarding claim 11, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 13, this claim is rejected by the reasoning applied in rejecting claims 2 and 5; furthermore, Suzuki discloses said cover is operable to deflect under external pressure and cause said conductive polymer to contact said digitizing element and activate said digitizer (see Fig. 1A; Column 7, Line 42 - Column 8, Line 67).

Regarding claim 15, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 17, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 18, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 19, this claim is rejected by the reasoning applied in rejecting claims 1 and 10; furthermore, Suzuki discloses a second cover [Fig. 12; 480] coupled to said first cover, wherein said first and second covers enclose said display and said digitizer (see Column 14, Line 55 - Column 15, Line 17).

Regarding claim 21, this claim is rejected by the reasoning applied in rejecting claims 2, 5, and 13.

Regarding claim 22, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 24, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 25, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 29, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 30, this claim is rejected by the reasoning applied in rejecting claims 2, 5, and 13.

Regarding claim 31, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 32, Suzuki discloses said first cover comprises at least one transparent portion [Fig. 1A; 4A] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 33, Suzuki discloses said digitizer comprises a resistive digitizer [Fig. 10; 4] (see Column 13, Line 50 - Column 14, Line 29).

Regarding claim 34, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 37, this claim is rejected by the reasoning applied in rejecting claim 19.



Regarding claim 38, this claim is rejected by the reasoning applied in rejecting claim 32.

Regarding claim 39, this claim is rejected by the reasoning applied in rejecting claim 33.

### ***Response to Arguments***

7. Applicants' arguments filed 19 July 2007 have been fully considered but they are not persuasive.

The applicants contend the cited prior art of ***Suzuki (US 6,529,188 B1)*** neglects teaching, a "cover overlap[ping] a side of said display" (see Pages 12-13 of the 'Response to Final Office Action Accompanying RCE' filed 19 July 2007). However, the examiner respectfully disagrees.

Suzuki discloses a cover [Fig. 1A; 4A] disposed above a digitizer [Fig. 1A; 11 and 12] and for enabling said deformation of said digitizer in response to a contact with said cover, wherein said cover [see Fig. 10; 4] overlaps (i.e., *to lie or extend over and cover a part of; to partially extend over; coincide partially or wholly*) a side of a display [Fig. 10; 1] (see Fig. 12; Column 7, Line 42 - Column 8, Line 67).

The applicants also contend the cited prior art of ***Suzuki (US 6,529,188 B1)*** neglects teaching, a "cover [that] further comprises a decorative border" (see Pages 13-14 of the 'Response to Final Office Action Accompanying RCE' filed 19 July 2007). However, the examiner again respectfully disagrees.

Suzuki discloses said cover further comprises a "decorative border" [Fig. 11A; 15 and 20] (see Column 14, Lines 30-54 -- *wherein the border inherently serves an esthetic purpose*).

By such reasoning rejection of the claims is deemed necessary, proper, and thereby maintained at this time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeff Piziali  
17 September 2007